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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,391	09/24/2001	Hiroko Suzuki	DAIN:493A	7852

7590 11/17/2004  
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EXAMINER

JACKSON, MONIQUE R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/960,391

**Applicant(s)**

SUZUKI ET AL.

**Examiner**

Monique R Jackson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed 8/30/04 has been entered. Claims 22-26 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 24 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 24 recites that the hardcoat layer is conductive however this limitation is found in parent claim 22.

### ***Claim Rejections - 35 USC § 103***

3. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niimi et al (USPN 6,146,753) or Niimi et al (USPN 6,503,627) in view of Ota et al (USPN 5,925,438) or Suzuki et al (6,033,743) or Oka et al (6,064,524.) Niimi et al teach an antistatic hardcoat film comprising a transparent substrate, a transparent conductive layer formed on the substrate, and a hardcoat layer formed on the conductive layer wherein the hardcoat layer comprising an anisotropic conductive layer of which the volume resistivity in the direction of the plane in the layer is higher than that in the layer thickness direction and may be formed from a reaction curing resin composition, and wherein the film may be provided with surface irregularities to produce a matted finish (Abstract; Col. 2-4; Figures; Claims.) Niimi et al do not teach a low refractive-index layer formed on the hardcoat layer however it would have been obvious to one having ordinary skill in the art at the time of the invention to include an outer layer on the hardcoat layer wherein the outer layer has a lower refractive index than the hardcoat layer in

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order to provide antireflection properties to the multilayer film as taught by Ota or Suzuki or Oka. Further, though Niimi et al do not teach that the hardcoat layer is formed from a plurality of layers, it is noted that a single layer of a material having a desired thickness is equivalent to a plurality of layers of the same material having a total thickness equal to the desired thickness of the single layer and hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the desired number of hardcoat layers to provide the desired thickness for the hardcoat layer in the film taught by Niimi et al.

4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

#### ***Double Patenting***

5. Claims 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,146,753, Niimi et al, in view of Ota et al or Suzuki et al or Oka et al, all commonly assigned. Though the instantly claimed invention is not identical to the claims of the commonly assigned Niimi patent, they are not patentably distinct because it would have been obvious to one having ordinary skill in the art at the time of the invention to include an outer layer on the hardcoat layer wherein the outer layer has a lower refractive index than the hardcoat layer and surface irregularities, in order to provide antireflection properties to the multilayer film as taught by Ota or Suzuki or Oka. Further it is noted that a single layer of a material having a desired thickness is equivalent to a plurality of layers of the same material having a total thickness equal to the desired thickness of the single layer and hence, it would have been obvious to one having ordinary skill in the art at the time of

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the invention to provide the desired number of hardcoat layers to provide the desired thickness for the hardcoat layer in the final film.

6. Claims 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,503,627, Niimi et al, in view of Ota et al or Suzuki et al or Oka et al, all commonly assigned. Though the instantly claimed invention is not identical to the claims of the commonly assigned Niimi patent, they are not patentably distinct because it would have been obvious to one having ordinary skill in the art at the time of the invention to include an outer layer on the hardcoat layer wherein the outer layer has a lower refractive index than the hardcoat layer and surface irregularities, in order to provide antireflection properties to the multilayer film as taught by Ota or Suzuki or Oka. Further it is noted that a single layer of a material having a desired thickness is equivalent to a plurality of layers of the same material having a total thickness equal to the desired thickness of the single layer and hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the desired number of hardcoat layers to provide the desired thickness for the hardcoat layer in the final film.

7. Applicant's arguments with respect to claims 22-26 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

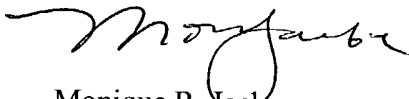
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
November 9, 2004